

### **REMARKS**

In response to the Office Action mailed October 3, 2003, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to place the present application in condition for immediate allowance, claims 5, 10, 24 and 26 have been amended and claims 2-4, 7-9, 12-20, 34, 42-43, and 45-46 have been canceled in view of the election/restriction requirements in the present Official Action.

#### **Amended Claims**

Claims 5 and 10 have been amended to make them more clear and definite and to overcome the rejections under 35 U.S.C. §112 first and second paragraphs. Claim 24 was amended to indicate that the non slip pad is flexible and Claim 26 was amended to indicate that the acrylate adhesive is disposed on one of the surfaces of an acrylate polyurethane tape. None of the amended claims add new matter and none of the amended claims require an additional search on behalf of the examiner.

#### **Election/Restrictions**

In response to the requirement to elect a single disclosed species for prosecution, applicant elects a single species as provided in claims 1, 5, 10, 21-32, 35-41, and 44. In view of this election, applicant has canceled without prejudice, the withdrawn claims 2-4, 7-9, 12-20, 34, 42-43, and 45-46.

#### **Rejections Under 35 U.S.C. § 112, first paragraph**

Claims 5 and 10 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

**Claim 5:** With respect to claim 5, the examiner has stated that the claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed had possession of the claimed invention. More particularly, the examiner has stated that claim 5 defines the invention as a kit having a "a decoration to be applied to said bottom surface." In view of the specification a page 4, lines 4-8 that provides the pad is trimmable and has a bottom surface layer that is decorated with a design, applicant has amended claim 5 to specify " a decoration disposed on said bottom surface." which is fully supported by the specification as originally filed.

**Claim 10:** With respect to claim 10, the examiner has stated the method provides "decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture" in addition to a trimmable pad with adhesive with a peelable film. The examiner has further stated that claim 10 suggests that the pad is not only attached to a body part but to either a number of particular materials. In response to this rejection, applicant has amended claim 10 to be more clear and definite by specifying, "said bottom surface including a decoration from at least one of the group comprising color, pattern, graphic design, text, advertising, relief design and texture".

With respect to the examiner stating that claim 10 suggests that "the pad is not only attached to a body part but to either a number of particular materials", attorney for applicant respectfully disagrees. Nevertheless, claim 10 has been further amended to make it more clear and definite that the pad is applied to only a selected body part.

In view of the foregoing, attorney for applicant respectfully requests that the rejection of claims 5 and 10 under 35 U.S.C. Section 112, first paragraph be withdrawn.

**Rejections Under 35 U.S.C. § 112, second paragraph**

Claim 10 has been rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regard as her invention. In this regard, the examiner has stated that in Paper No 7, filed May 20, 2002 that applicant has stated that the pad is decorated and applied directly to the wearers body, and that this statement indicates that the invention is different from what is defined in the claims because the present invention alludes to the pad having a decorated side, an adhesive side and where the adhesive side has a removable cover which can be applied to the user's body or to a separate pre-formed cupped pad or material selected from a particular group as recited in claim 10.

Responsive to this rejection, claim 10 has been amended to make it more clear and definite and to indicate that the pad is applied "only" to a selected body part.

In view of the foregoing, attorney for applicant respectfully requests that the rejection of claim 10 under 35 U.S.C. Section 112, second paragraph be withdrawn.

**Claim Objection**

The examiner has stated that claim 26 appears to be incomplete and that correction is required. In response to this objection, applicant has amended claims 26 to indicate the "a layer of acrylate adhesive on one of its surfaces".

**Rejections Under 35 USC §102(b)**

Claims 21-24, and 29-32 have been rejected under 35 USC §102(b), as being anticipated by *Yonkers (US 3,985,383)*.

**Claim 21:** Claim 21 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 21 as previously amended specifies amongst other things, as follows:

"21. A novelty fashion wear item, comprising:  
a flexible pad having an upper surface and a lower surface with a non-slip texture;

said pad being sufficiently flexible to conform to a contoured surface area of a body part;  
 said pad having its entire upper surface coated with an adhesive material for removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area; and  
 said pad having its lower surface provided with indicia to decorate said contoured surface area."

Nowhere is this combination of elements and steps described in, nor suggested by the *Yonkers reference*

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the *Yonkers reference*, which fails to show all of the essential elements of the instant invention.

The *Yonkers reference* describes an indexing or separating device not a fashion wear item that is embodied within a novelty kit. More specifically the *Yonkers reference* describes a layer of plastic film 14 that has an upper surface 19 and a bottom surface 15, where the bottom surface 15 is coated with a pressure sensitive adhesive material 16 that enables the layer of plastic film 14 to be attached to the finger 11 of a user. The *Yonkers reference* further discloses that the layer of plastic film 14 is flexible so as to conform easily to the contour of the finger 11, or in the alternatively, it is rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated. With reference to the *Yonkers reference* teaching that the layer of plastic film 14 is a support element, the *Yonkers reference* further provides that the upper surface 19 is coated with a layer of cement that secures a mass of traction material 18 to the upper surface, where the mass of traction material 18 has a very high coefficient of

friction with respect to the objects to be indexed and is composed of an elastomeric material such as foam and sponge rubber containing glycerine; or in an alternative embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched to increase its traction capability or rubber threads which have been released from a liquid rubber container onto the plastic layer of film 14.

Turning now to the comments of the examiner relative to what is taught by the *Yonkers reference*:

1. Yonkers provides ... The pad having its lower surface provided with indicia to decorate the contoured surface area (column 4, lines 10-19). Column 4, lines 10-19 merely provides that "the indexing device 10 includes variations of color and shape (FIG. 6) of both the mass of traction material 18 and the layer of plastic film 14. For example, the device 10 may be formed in the shape of a heart 22, a square, a clover 26 or a diamond 28." In this case, there is no teaching or disclosure that the lower surface of the device 10 is "provided with indicia to decorate said contoured surface areas." Instead the *Yonkers reference* is teaching that the elements of the device 10: the layer of plastic material 14, and the mass of traction material 18 can have a color or can be shaped to a desired configuration. There is nothing however, to suggest that indicia in the form of advertisement or text is disposed on the lower surface; instead the *Yonkers reference* teaches away from this since the lower surface of the layer of plastic film 14 is coated with a cement to secure the mass of traction material 18 to its support element, the layer of plastic film 14.

2. That Yonkers provides.... the non skid pad has sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface (column 3, lines 14-29). Column 3, lines 14-19 provides:

"In accordance with a further important feature of the present invention, a mass of traction material 18 having a very high coefficient of friction with respect to the objects to be indexed is disposed on a second side or surface 19 of the film 14. The mass of traction material 18 may be of the same general configuration as the layer of plastic film 14 and may be attached thereto by cement. The mass of traction material 18 may, in a specific embodiment, be

an elastomeric material such as foam and sponge rubber containing glycerine; or in an alternate embodiment, the mass of traction material 18 may be smooth rubber stock that has been cross-cut or hatched (FIG. 3) to increase its traction capability. The mass of traction material 18 may alternately comprise rubber threads which are released from a liquid rubber container onto the plastic layer of film 14."

There is nothing in this cited text that would suggest that thickness has been considered to protect the finger of a user when brought into engagement with the ground. This is obvious, since the *Yonkers reference* only discusses rigidity as a means for protecting the finger and moreover, the device 10 is not something that engages the ground for indexing purposes, but instead is an indexing device for separating adjacent planar objects, such as stacked sheets of paper. (See Column 2, lines 52-54). In this regard, there is nothing in the cited text that would suggest that the layer of plastic film 14 is a pad with a non slip texture.

3. The Yonkers reference provides.... The flexible pad conforms to the user's fingers and is made out of foam and sponge rubber (Column 2, lines 14-50). As quoted above, only the mass of traction material 18 is described as being composed of foam and sponge rubber. The "pad" as utilized in the context of the cited reference refers to the layer of plastic film 14. Therefore there is no teaching or suggestion in the *Yonkers reference* that the layer of plastic film 14 is made out of foam and sponge rubber.

4. That Yonkers provides.... The non-skid pad of Yonkers is capable of being trimmed and disposed of after use. Yonkers would seem to teach away from trimming the device 10 since the *Yonkers reference* teaches that "it is believed that the excellent adhesion of the layer of plastic film 14 to the finger 11 results from the extension of the outer periphery of the layer of plastic film 14 beyond the outer periphery of the mass of traction material 18, that is, the mass of traction material 18 has a smaller cross sectional area than the cross-sectional area of the layer of plastic film 14. Therefore if a user would trim the device to fit the finger of a small person, it could well result in a disruption of the desired cross-sectional relationship between the film 14 and the mass of traction material 18.

5. That Yonkers provides.... a method of providing a decorative pad with a non slip texture to the finger of a user (Column 1, lines 66-68 through column 2, lines 1-2.)

The cited text provides:

An additional object of the present invention is to provide a new and improved device for indexing or separating adjacent planar objects that is attractive in appearance and does not readily produce skin irritation."

There is nothing in this cited text to suggest that the film material 14 includes decorative indicia or that the film material 14 has a non slip texture.

### **Specific Claim Rejections**

**Claim 21:** Considering now the specific rejection of claim 21 in greater detail, the novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "a flexible pad having an upper surface and a lower surface with a non-slip texture..." Instead the *Yonkers reference* teaches a flexible layer of plastic film 14 that serves as a support element for the mass of traction material 18, which material 18 has a very high coefficient of friction to facilitate separating adjacent planar objects, such as sheets of paper as illustrated in FIG. 2. In this regard, it is the mass of traction material 18 that has the non slip texture, not the layer of plastic film 14.

Secondly, the *Yonkers reference* does not teach, nor suggest, "removably securing said pad to said contoured surface area of a body part to facilitate decorating said contoured surface area." Instead the *Yonkers reference* teaches that a layer of plastic film 14 is attached to the finger of a user wishing to index or separate adjacent planar objects 12, such as sheets of paper as illustrated in FIG. 2. (Col 2, lines 51-54). Moreover, the *Yonkers reference* teaches that the layer of plastic film 14 is a support element for the mass of traction material 18. In short, the plastic film 14 is not a platform for decorative indicia.

Finally, the novel features and steps of the present invention are not suggested, nor taught by the *Yonkers reference* in that the *Yonkers reference* does not suggest, nor teach "said pad having its lower surface provided with indicia to decorate said contoured surface area." Instead, the *Yonkers reference* teaches the other surface of the film 14 is coated with a layer of cement (Col 3, lines 18-21) that secures to that surface the mass of traction material 18.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 21 as previously amended patentably distinguishes over the *Yonkers reference*.

**Claim 22:** Claim 22 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 22 as previously amended specifies amongst other things, as follows:

"22. A method of decorating a body part, comprising the steps of:  
providing decorative fashion wear;  
said fashion wear including:  
a flexible pad with a non-slip texture, said pad having an upper surface and a lower surface and being sufficiently flexible to conform to a contoured surface area of the body part;  
providing the entire upper surface with an adhesive material for removably securing said pad to the contoured surface area of the body part;  
providing the lower surface with indicia to decorate the contoured surface area of the body part; and  
applying said decorative fashion wear to the contoured surface area of the body part for decorating purposes."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not disclose, nor suggest "providing decorative fashion wear..." Instead, the *Yonkers reference* teaches an indexing device 10 not fashion wear.



Secondly, the *Yonkers reference* does not teach nor disclose "a flexible pad with a non-slip texture". Instead the *Yonkers reference* teaches a layer of plastic film **14** having affixed to one of its surfaces "a mass of traction material **18**". In short, there is nothing to suggest that the layer of plastic **14** has a non slip texture; instead it is the mass of traction material **18** that has the non-slip texture.

Thirdly, the *Yonkers reference* does not suggest nor disclose, "said pad having its lower surface provided with indicia to decorate said contoured surface area." Instead, the *Yonkers reference* teaches that both its upper and lower surfaces are coated with an adhesive material and that the device **10** is for indexing or separating adjacent planar objects not for decorating purposes.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 22 as previously amended patentably distinguishes the *Yonkers reference*.

**Claim 23** Claim 23 as previously amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 23 as originally filed specifies amongst other things, as follows:

"23. A fashion wear item, comprising:  
a non-slip pad having a non-skin irritating adhesive material completely covering one of its surfaces and decorative indicia covering at least a portion of another one of its surfaces....."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not teach nor disclose, "a non-slip pad..." Instead the *Yonkers reference* teaches a layer of plastic film **14** that function as a support element for a mass of traction material **18** that is affixed by cement to one of its surfaces.

Finally, the *Yonkers reference* does not suggest nor disclose "a non slip pad having ...decorative indicia covering at least a portion of another one of its surfaces..."

Instead, the *Yonkers reference* teaches a layer of plastic film 14 having both of its surfaces coated with an adhesive material.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 23 as previously amended patentably distinguishes over the *Yonkers reference*.

**Claim 24** Claim 24 as amended patentable distinguishes over the *Yonkers reference*. In this regard, claim 24 as amended specifies amongst other things, as follows:

"24. The fashion wear item according to claim 23, wherein said non-skid pad is flexible and has a sufficient thickness to protect said contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface."

The novel steps of the present invention are not disclosed, nor suggested by the *Yonkers reference* in that the *Yonkers reference* does not teach nor disclose, " wherein said non-skid pad is flexible and has a sufficient thickness to protect said contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface.." Instead the *Yonkers reference* teaches a layer of plastic film 14 that is "rigid to serve not only as a support element but also as protection against punctures caused by the objects being indexed or separated." (Col 2, lines 62-65). In short, the *Yonkers reference* teaches away from the device 10 being flexible and having a sufficient thickness to protect said contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface". More specifically, the *Yonkers reference* teaches, "that if the mass of traction material 18 is relatively thick, better adhesion to the finger 11 by the device 10 results if a peripheral edge 18a (FIG. 4) of the mass of traction material 18 is tapered." Therefore, claim 24 patentably distinguishes over the *Yonkers reference* for the reasons given as well as under the same rationale as set forth earlier relative to claim 23.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 24 as amended patentably distinguishes over the *Yonkers reference*.

**Claim 29:** Claim 29 as originally filed patentably distinguishes over the *Yonkers reference*. In this regard, claim 29 as originally filed specifies amongst other things, as follows:

"29. The fashion wear item according to claim 23, wherein said non-skid pad is sufficiently flexible to conform to the contour of user selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbows of a user to provide decoration for the body part selected."

Claim 29 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would indicate that the indexing device 10 would be suitable for use with other body parts selected from the hands, feet, toes, knees and elbows of a user.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 29 as originally filed patentably distinguishes over the *Yonkers reference* under the same rationale as set forth earlier relative to claim 23 and as well as for the reasons given herein.

**Claim 30:** Claim 30 as originally filed patentably distinguishes over the *Yonkers reference*. In this regard, claim 30 as originally filed specifies amongst other things, as follows:

"30. The fashion wear item according to claim 24, wherein said non-skid pad is selected from a group of materials consisting of rubber, fabric, paper, plastic, synthetic materials, leather, and polyurethane foam."

Claim 30 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition there is nothing in the *Yonkers reference* that would indicate that anything other than a layer of plastic film 14

would be a suitable support device for the mass of traction material 18. Therefore, the *Yonkers reference* fails to teach or suggest that the support film 14 could be selected from "a group of materials consisting of rubber, fabric, paper, synthetic materials, leather, and polyurethane foam."

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 30 as originally filed patentably distinguishes over the *Yonkers reference*.

**Claim 31:** Claim 31 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 31 as originally filed specifies amongst other things, as follows:

"31. The fashion wear item according to claim 30, wherein said non-skid pad is trimmable and disposable after use.

Claim 31 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, as noted earlier there is nothing in the *Yonkers reference* that would suggest that the layer of plastic film 14 is trimmable. In this regard, the *Yonkers reference* seems to teach away from trimming the device 10 or more specifically the layer of plastic film 14 and the mass of traction material 18, since the *Yonkers reference* teaches that "it is believed that the excellent adhesion of the layer of plastic film 14 to the finger 11 results from the extension of the outer periphery of the layer of plastic film 14 beyond the outer periphery of the mass of traction material 18, that is, the mass of traction material 18 has a smaller cross sectional area than the cross-sectional area of the layer of plastic film 14. Therefore if a user would trim the device or more specifically the layer of plastic film 14 and mass of traction material 18 to fit the fingers of a small person, it could well result in a disruption of the desired cross-sectional relationship between the film 14 and the mass of traction material 18.

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 31 as originally filed patentably distinguishes over the *Yonkers reference*.

**Claim 32:** Claim 32 as originally filed patentable distinguishes over the *Yonkers reference*. In this regard, claim 32 as originally filed specifies amongst other things, as follows:

"32. The fashion wear item according to claim 23, wherein the decorative indicia is selected from an indicia group consisting of color, patterns, messages, trademarks, and advertisements."

Claim 32 patentably distinguishes over the *Yonkers reference* under the same rationale as set forth above relative to claim 23. In addition, there is nothing in the *Yonkers reference* that would suggest that decorative indicia covers at least a portion of one of the surfaces of the layer of plastic film 14. More specifically, the *Yonkers reference* teaches that both surfaces of the plastic film 14 are covered with an adhesive material. One surface is covered with an adhesive material to enable the plastic film 14 to be attached to the finger of a user, and the other surface is coated with a cement material to enable the mass of traction material to be attached to the other surface. Therefore the *Yonkers reference* teaches away from decorative indicia covering at least a portion of another one of its surfaces, "wherein the decorative indicia is selected from an indicia group consisting of ...messages... and advertisements."

Thus, while the *Yonkers reference* may teach an indexing device, the *Yonkers reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 32 as originally filed patentably distinguishes over the *Yonkers reference*.

### **Rejections Under 35 USC §103**

Claim 25 has been rejected under 35 USC §103 as being unpatentable over *Yonkers* in view of *Gamble et al* (US 6,440,526).

**Claim 25:** Claim 25 as originally filed patentable distinguishes over the *Yonkers reference in view of Gamble et al. (US 6,440,526)*. In this regard, claim 25 as originally filed specifies amongst other things, as follows:

"25. The fashion wear item according to claim 24, wherein said non-skid pad is a pad ethylene vinyl acetate having a thickness of about one sixteenth of an inch."

*The Gamble et al reference* discloses a pad 11 having a non-slip surface, where the pad 11 is adapted to be attached to a substrate and for use in combination with a garment worn by a person.

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference in view of Gamble* in that the cited references either alone or in combination fail to disclose or teach " wherein said non-skid pad is a pad ethylene vinyl acetate having a thickness of about one sixteenth of an inch." Therefore claim 25 patentably distinguishes over the cited references under the same rationale as set forth above with reference to claim 23.

In addition, there is nothing to suggest combining the two references as suggested by the examiner. In this regard, the *Yonkers reference* does not teach either a non-slip decorative pad as described in claim 23 nor that the pad (a layer of plastic film 14) is made out of ethylene vinyl acetate having a thickness of one sixteenth of an inch.

Secondly, there is nothing in either of the cited references that would motivate one skilled in the art to substitute a layer of ethylene vinyl acetate in the place and stead of the layer of plastic film 14. The *Gamble et al. reference* indicates in the abstract that the pad 11 is adapted for attachment to a substrate, not the finger or other body part of a user, and that the pad is further adapted to be used in combination with a garment worn by a person. There is nothing in the *Yonkers reference* that would suggest that the layer of plastic 14 is to be used in combination with a garment worn by a user. Moreover, there is nothing in the *Gamble et al reference* that would suggest that the substrate to which the pad 11 would be attached to would be a body part. Instead, the *Gamble et al reference* at Col 2, lines 12-14 provides: " The pad of the present invention may be used

for any application where it is desirable for a person's grip on a surface to be enhanced. For example, the pad can be in the form of a mat for placement on slippery surfaces such as set floors and also snow and ice. The pad may also be adapted to be attached to the surface of articles such as surfboards, body boards, skateboards, jet skis, sailboards and yachts. In short, there is nothing to suggest that the pad is suitable as a support element for a mass traction material 18 as taught by the *Yonkers reference*. Moreover, it is clear from the *Yonkers reference* that only the mass traction material 18 is utilized for indexing or separating adjacent sheets of planar material and not the layer of plastic 14, which is only a support element for the mass traction material 18.

Finally, the cited references do not teach, nor suggest that the support element 14 should have a thickness of 1/16th of an inch. The examiner has stated that the dimension of one sixteenth of an inch is arbitrary and therefore obvious. Attorney for applicant respectfully disagrees. In this regard, claim 24, from which claim 25 depends provides that "wherein said non-skid pad has a sufficient thickness to protect said contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface." Moreover, the specification provides in pertinent part as follows:

"[0028] As shown best in cross section in FIG. 7, pad 10 includes top surface 12 and bottom surface 13. As shown in FIG. 18, the several layers of a kit include the pad 10 made of ethylene vinyl acetate (EVA) (EVA-most preferred thickness is {fraction (1/16")}) thick), a two sided acrylic, pressure sensitive adhesive transfer tape 17 on the top surface 12, a layer of MSX 5527 acrylate adhesive 14 (a polyurethane backing with acrylate adhesive may be obtained from 3 M Healthcare as MSX 5527 acrylate polyurethane 1.2 mil thick tape), and a peel sheet 18 protecting the adhesive until ready to use. The bottom surface 13 is decorated for viewing by third parties who will see the decoration as a fashion item, e.g., sandal, glove, or knee cover. The decoration may be color, pattern, text, advertising, relief design and texture, and combinations thereof. A presently preferred mode is screen printed on EVA. Pad 10 can be made of a variety of materials including rubber, fabric, paper, plastic, synthetic materials, leather, and polyurethane foam. The material chosen for pad 10 should be of a durable yet flexible character so as to withstand wear caused by walking on the bottom surface as well as provide flexibility and comfort to the foot while walking."

Based on the foregoing attorney for applicant respectfully asserts that the dimension of 1/16th of an inch is " a sufficient thickness to protect the contoured area of

a user from abrasion when the pad is brought into engaging contact with a ground surface."

Thus, while the *Yonkers reference* in combination with the *Gamble et al reference* may teach an indexing device having a textured component 18, the *Yonkers reference in view of the Gamble et al reference*, either taken alone or in combination with one another, do not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 25 as originally filed patentably distinguishes over the cited references taken alone or in combination with one another.

**Claim 26:** Claim 26 has been rejected under 35 USC §103 as being unpatentable over Yonkers in view of Muchin (US 5,718,224).

Claim 26 as amended patentable distinguishes over the *Yonkers reference in view of Muchin (US 5,718,224)*. In this regard, claim 26 as amended specifies amongst other things, as follows:

"26. The fashion wear item according to claim 24, wherein said adhesive material includes an acrylate polyurethane tape having about a 1.2 mil thickness with a layer of acrylate adhesive on one of its surfaces."

The *Muchin reference* teaches a nasal dilator 10 for preventing outer wall tissue of nasal passages of a nose from drawing in during breathing. There is a spring member 15 for bridging a human nose, the spring member 15 extending the bridge and at least partly beyond the bridge on both sides of the bridge. A pad 23 with an adhesive 26 on its bottom surface covers the spring member 15 and extends around the spring member 15 so that there is a perimeter of space formed between the spring member 15 and the pad member 23. The spring 15 is inset centrally in the pad 23. There is an adhesive between the spring member 15 and the pad 23 such that the spring member 15 on one of its entire engaging surface wholly adheres with the pad 23. A surface perimeter area of the pad 23 is formed between the outer edge of the spring member 15 and the peripheral edge of the pad 23. The surface perimeter area of the pad 23 includes an adhesive 26 for adhering to the skin of the nose. The material of the pad 23 is preferably 9906T, 3M Elastic Nonwoven Tape from 3M Company, 3M Center, St. Paul, Minn. The product is a tan



elastic polyurethane tape coated on one side with an acrylate adhesive 26. The tape is supplied on a paper liner 152 with the liner on the inside of the roll." (Col 3, lines 31-40). The surface area 17 of the spring 15 includes an adhesive carrier 20 for adhering to the skin of the nose. The adhesive carrier 20 with an adhesive 21 and 22 on its respective surfaces is preferably No. 1509, Double Coated Medical Tape on Liner from 3M Company, 3M Center, St. Paul, Minn. This product is a double-coated transparent polyethylene film, coated on both sides with a hypoallergenic, pressure-sensitive, acrylate adhesive, supplied on a paper liner. The double-coated tape is wound with a liner on the outside of the roll. (Column 4, lines 27-35)

With respect to the *Muchin reference* the examiner has stated that although the *Yonkers reference* fails to teach that the adhesive material is acrylate polyurethane tape having a thickness of 1.2 millimeters, the Muchin reference provides a pad having an adhesive material made out of acrylate polyurethane tape, citing column 3, lines 35-40 which provides:

"The pad material 23 is preferably 9906T, 3M Elastic Nonwoven Tape from 3M Company, 3M Center, St. Paul, Minn. The product is a tan elastic polyurethane tape coated on one side with an acrylate adhesive 26. The tape is supplied on a paper liner 152 with the liner on the inside of the roll."

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference in view of Muchin* in that the cited references either alone or in combination fail to disclose or teach " wherein said adhesive material includes an acrylate polyurethane tape having about a 1.2 mil thickness with a layer of acrylate adhesive on one of its surfaces."

More specifically, the specification discloses:

"[0028] As shown best in cross section in FIG. 7, pad 10 includes top surface 12 and bottom surface 13. As shown in FIG. 18, the several layers of a kit include the pad 10 made of ethylene vinyl acetate (EVA) (EVA-most preferred thickness is {fraction (1/16")}) thick), a two sided acrylic, pressure sensitive adhesive transfer tape 17 on the top surface 12, a layer of MSX 5527 acrylate adhesive 14 (a polyurethane backing with acrylate adhesive may be obtained from 3 M Healthcare as MSX 5527 acrylate polyurethane 1.2 mil thick tape), and a peel sheet 18 protecting the adhesive until ready to use."

The specific structure of first a two-side acrylic, pressure sensitive adhesive transfer tape 17 on the top surface 12 and a layer of MSX 5527 acrylate adhesive 14 with a polyurethane backing attached to the transfer tape 17 is an important feature of the present invention as claimed. This specific structure is not taught by the *Muchin reference* either taken alone or in combination with the *Yonkers reference*. That is, the *Yonkers reference* teaches that one side of the layer of plastic film 14 is coated with a pressure sensitive adhesive material 16 (FIG.4) to enable the layer of plastic film 14 to be attached to the finger 11 or to another object. In the claimed invention however, the single sided adhesive 14 with the polyurethane backing is not attached to the pad 12, but instead is attached to a double sided tape 17 that has one of its surfaces wholly adhered to the pad 12, and the other one of its surfaces wholly adhered to the polyurethane backing of the single side tape, which has its opposite surface coated with the acrylate adhesive 14. (See FIG. 18). There is nothing in the *Yonkers reference* or the *Muchin reference* whether taken alone or in combination that discloses or suggests this unique structure as claimed.

Thus, while the *Yonkers reference* in combination with the *Muchin reference* may teach an indexing device having a layer of plastic with one of its surfaces coated with an adhesive material, the *Yonkers reference in view of the Muchin reference*, either taken alone or in combination with one another, does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 26 as amended patentably distinguishes over the cited references.

**Claim 27:** Claim 27 has been rejected under 35 USC §103 as being unpatentable over Yonkers in view of Lee (US 6,613,382).

Claim 27 as originally filed patentable distinguishes over the *Yonkers reference in view of Lee (US 6,613,382)*. In this regard, claim 27 as originally filed specifies amongst other things, as follows:

"27. The fashion wear item according to claim 23, wherein the decorative indicia is screen printed on said non-skid pad.

The *Lee reference* discloses a method of manufacturing a plurality of note posters from a planar vinyl sheet having a printed surface and an opposing adhesive surface provides for first printing a plurality of images upon the printed surface.

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers reference in view of Lee* in that the cited references either alone or in combination fail to disclose or teach, "wherein the decorative indicia is screen printed on said non-skid pad." More particularly, the *Yonkers reference* teaches that the subject surface is coated with a cement to secure the mass traction material 18 to the surface of the layer of plastic 14. Therefore the *Yonkers reference* teaches away from printing on the surface of the plastic material 14 that is attached to the mass traction material 18. Accordingly, claim 27 as originally filed patentably distinguishes over the cited references for the reasons given as well as under the same rationale as set forth above with reference to claim 23.

**Claim 28:** Claim 28 has been rejected under 35 USC §103 as being unpatentable over Yonkers and Gamble et al. in view of Lee (US 6,613,382).

Claim 28 as originally filed patentable distinguishes over the *Yonkers and Gamble et al references in view of Lee (US 6,613,382)*. In this regard, claim 28 as originally filed specifies amongst other things, as follows:

"28. The fashion wear item according to claim 25 wherein the decorative indicia is screen printed on said pad of ethylene vinyl acetate."

The novel features of the present invention are not disclosed, nor suggested by the *Yonkers and Gamble et al. references in view of Lee* in that the cited references either alone or in combination fail to disclose or teach " wherein the decorative indicia is screen printed on said pad of ethylene vinyl acetate." More particularly, the *Yonkers reference* teaches that the subject surface is coated with a cement to secure the mass traction material 18 to the surface of the layer of plastic 14. Therefore the *Yonkers reference* teaches away from printing on the surface that is attached to the mass traction material 18. Accordingly, claim 28 patentably distinguishes over the cited references for the

reasons given as well as under the same rationale as set forth above with reference to claim 23.

### **Claim Rejections in General**

In reviewing the specific claim rejection set forth by the examiner, attorney for applicant has noted that only claims 5, 10, and 21-32 have been rejected although claims 1, 35-41 and 44 are currently pending in the case. In this regard, the examiner has made no objections or rejections to claims 1, 35-41 and 44. In view of the foregoing, attorney for applicant assumes that claim 5 and its dependent claim 1, as well as claim 10 and its dependent claims 35-41 and 44 are now in condition for immediate allowance and such action is earnestly requested.

### **Conclusion**

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: October 9, 2003

respectfully submitted,

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